

REMARKS/ARGUMENTS

Claims 20-29 and 32-68 are pending. Claims 1-19 and 30-31 are canceled. Claims 24-29, 35, 36, 46-52, and 57-61 are withdrawn pursuant to a Restriction Requirement. Claims 20-23, 32-34, 37-45, 53-56, and 62-68 are currently under examination and stand substantively rejected. In this Amendment, claims 20, 41, 45, and 67 are amended. Reconsideration of the claims is respectfully requested.

Claim Amendments

The claim amendments conform with the Group and Species (i.e. Group II and Species I/Fig. 2) which were elected in response to the Restriction Requirement dated January 9, 2007. Support for amended claims 20, 41, 43, and 67 can be found in the originally filed disclosure at, for example, paragraph [0034] and Fig. 2. No new matter is introduced.

Rejection Under 35 U.S.C. §102

Claims 20-23, 32-34, 37, 39-43, 45, 53-54, 56, 63, and 65 were rejected under 35 U.S.C. §102(e) as allegedly anticipated by U.S. Patent Publication No. 2003/0010346 to Paolitto et al. ["Paolitto"]. This rejection is traversed.

According to MPEP 2131, in order to anticipate a claim, a reference must teach each and every element of the claim. Paolitto does not meet this test.

Independent Claim 20

Amended claim 20 is directed to a system for enhancing minimally invasive heart surgery. The system includes, among other things, a heart stabilizing device and a first coupling device. The first coupling device includes an elongate shaft having at least one flexible, rigidifying portion having a closed section that can be rigidified by applying suction.

Paolitto describes a surgical apparatus for transabdominal cardiac surgery. The Office Action alleges that the presently claimed rigidifying portion of the first coupling device is read on by the permanent weir (30) of Paolitto. Applicants disagree. As recited in amended claim 20, the rigidifying portion has a closed section that can be rigidified by applying suction. In contrast, there is no suggestion that Paolitto's permanent weir has a closed section that can be rigidified by applying suction. To the contrary, the weir (130) is shown and described as an

annular member disposed about the open end (115) of a cannula (10), where the cannula (10) has an proximal open end (116), a distal open end (115), and a hollow passageway (120). See Paolitto at Figs. 5A, 5B and 7, and paragraphs [0055], [0056], and [0085].

Presently pending claims 21, 22, 23, 24, 32-34, 37, 39, 40, and 63 depend directly or indirectly from amended claim 20, and are therefore allowable for depending from an allowable base claim, as well as for the novel combination of elements they recite.

Independent Claim 41

Amended claim 41 is drawn to a device for enhancing minimally invasive heart surgery. The device includes a surgical tool having a ball, and an elongate coupling member. The elongate coupling member includes an actuation device near the proximal end that can tighten the coupling means to the ball of the surgical tool and loosen the coupling means from the ball of the surgical tool. Paolitto does not teach or suggest this combination of elements.

Presently pending claims 42, 43, 45, 53-54, 56, and 65 depend directly or indirectly from amended claim 41, and are therefore allowable for depending from an allowable base claim, as well as for the novel combination of elements they recite. Withdrawal of this rejection is respectfully requested.

First Rejection Under 35 U.S.C. §103

Claim 38 was rejected under 35 U.S.C. §103(a) as allegedly obvious over Paolitto in view of U.S. Patent Publication No. 2002/0068855 to Daniel et al. ["Daniel"]. This rejection is traversed.

According to MPEP 2143, a *prima facie* case of obviousness requires, among other things, that the cited references when combined must teach or suggest all of the claim elements. The combination of Paolitto and Daniel does not meet this test.

Presently pending claim 38 depends indirectly from amended claim 20. As noted above, Paolitto does not teach or suggest a first coupling device which includes an elongate shaft having at least one flexible, rigidifying portion having a closed section that can be rigidified by applying suction. Daniel discusses an endoscopic retraction system, but does not remedy this deficiency of Paolitto. Thus, the combination of Paolitto and Daniel does not show all elements

of amended base claim 20, or claim 38 which depends therefrom. Withdrawal of this rejection is respectfully requested.

Second Rejection Under 35 U.S.C. §103

Claims 44 and 55 were rejected under 35 U.S.C. §103(a) as allegedly obvious over Paolitto in view of U.S. Patent Publication No. 2003/0060685 to Houser et al. ["Houser"]. This rejection is traversed.

According to MPEP 2143, a *prima facie* case of obviousness requires, among other things, that the cited references when combined must teach or suggest all of the claim elements. The combination of Paolitto and Houser does not meet this test.

Presently pending claims 44 and 55 depend directly or indirectly from amended claim 41. As noted above, Paolitto does not teach or suggest an elongate coupling member which includes an actuation device near the proximal end that can tighten a coupling means to a ball of the surgical tool and loosen the coupling means from the ball of the surgical tool.

Houser discusses a shape memory tissue stabilizer, but does not remedy this deficiency of Paolitto. Thus, the combination of Paolitto and Houser does not show all elements of amended base claim 41, or claims 44 and 55 which depends therefrom. Withdrawal of this rejection is respectfully requested.

Third Rejection Under 35 U.S.C. §103

Claims 62, 64, and 66-68 were rejected under 35 U.S.C. §103(a) as allegedly obvious over Paolitto in view of U.S. Patent Publication No. 2003/0010346 to Peng et al. ["Peng"]. This rejection is traversed.

According to MPEP 2143, a *prima facie* case of obviousness requires, among other things, that the cited references when combined must teach or suggest all of the claim elements. The combination of Paolitto and Peng does not meet this test.

Claims 62 and 64

Presently pending claims 62 and 64 depend from amended claim 20. As noted above, Paolitto does not teach or suggest a first coupling device which includes an elongate shaft having at least one flexible, rigidifying portion having a closed section that can be rigidified by

applying suction. Peng is cited for allegedly describing a rigidifiable arm coupled with a coupling device. However, Peng does remedy the deficiency of Paolitto's coupling device. Thus, the combination of Paolitto and Peng does not show all elements of amended base claim 20, or claims 62 and 64 which depend therefrom.

Claim 66

Presently pending claim 66 depend from amended claim 41. As noted above, Paolitto does not teach or suggest a surgical tool having a ball, and an elongate coupling member which includes an actuation device near the proximal end that can tighten a coupling means to the ball of the surgical tool and loosen the coupling means from the ball of the surgical tool. Peng is cited for allegedly describing a rigidifiable arm coupled with a coupling device. However, Peng does remedy the deficiency of Paolitto. Thus, the combination of Paolitto and Peng does not show all elements of amended base claim 41, or claim 66 which depends therefrom.

Claims 67 and 68

Amended independent claim 67 is drawn to a system for enhancing minimally invasive heart surgery. The system includes, among other things, a first coupling device with a flexible rigidifying portion having a closed section that can be rigidified by applying suction. The system also includes a first flexible arm coupled with the first coupling device via a first clamp, wherein the first flexible arm can be rigidified by applying suction.

The Office Action alleges that Peng shows the presently claimed flexible arm. However, as noted above, Paolitto does not teach or suggest the presently claimed coupling device. Hence, the combination of Paolitto and Peng does not show all elements of amended base claim 67, or claim 68 which depends therefrom. Withdrawal of this rejection is respectfully requested.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

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Examining Group 3735

PATENT

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

/Nathan S. Cassell/

Nathan S. Cassell
Reg. No. 42,396

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 303-571-4000
Fax: 415-576-0300
61170024 v1